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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,093	02/26/2002	Jeffrey J. Shea	10557/266546	5422

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 12/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,093

Applicant(s)

SHEA ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson et al. (US 5,925,077).

Williamson et al. disclose an implantable prosthesis 10 with a prosthetic or acetabular shell component 88 having first and second surfaces; (ii) an opening or aperture 90 extending from the first surface to the second surface wherein the aperture wall is tapered to form a frustoconical tapered section; and (iii) a plug or an “insertion member” or “an aperture cover” 98 with a spherical or near-spherical head 104 that mates with the aperture wall for a fluid-tight seal (col. 6, lines 35-51 and Figures 11A and 11B).

Regarding claims 25-26, Williamson discloses the implantable or acetabular prosthesis, used in total hip arthroplasty, as having a bearing member or liner 14 which provides an articulation surface for ball 180 of a femoral component 182 (col. 1, lines 7-12, col. 2, lines 41-48 and col. 9, lines 21-24).).

The method steps of claims 27-38 are inherently performed during normal use of the Williamson et al. prosthesis for total hip arthroplasty.

Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Khalili (US 6,228,121).

Regarding claims 1-24, Khalili discloses (i) an implantable prosthesis 100 with a prosthetic component 102 having first and second surfaces; (ii) an opening or aperture 106

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extending from the first surface to the second surface wherein the aperture wall 114 is tapered such that the inner most end 118 of the aperture is larger than the outermost end (frustoconical tapered section); and (iii) an insertion member or screw 108 with a spherical or near-spherical head 126 that mates with aperture wall 114 for a fluid-tight seal (col. 3, lines 28-33 and lines 61-67 and col. 4, lines 1-31).

Regarding claims 25-26, Khalili discloses the implantable or acetabular prosthesis, used in total hip arthroplasty, as having a bearing member or liner 104 which provides an articulation surface for ball 18 of a femoral component 20 (col. 1, lines 19-45 and Figure 1).

The method steps of claims 27-38 are inherently performed during normal use of the Khalili prosthesis for total hip arthroplasty.

Response to Arguments

Applicant's arguments under "REMARKS", in Paper No. 8, filed on October 14, 2003, with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

With regard to Applicants' argument on Page 13 that Williamson et al. do not disclose that hole 90 is "adapted to accommodate an insertion membercomponent," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Hole 90 of Williamson et al. can accommodate the insertion member inserted at multiple orientations relative to the component.

With regard to Applicants' argument on Page 13 that Khalili does not disclose that aperture 106 is not "adapted toscrew 108," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Aperture 106 of Khalili is adapted to receive fixation screw 108 at multiple orientations with respect to the central axis of the aperture via the sleeve component (col. 2, lines 40-48 and Figure 9).

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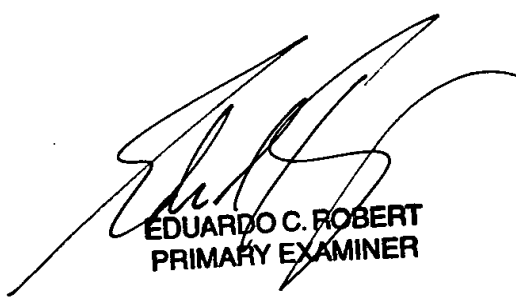
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:30 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

AR *Anu Ramana*
December 22, 2003


EDUARDO C. ROBERT
PRIMARY EXAMINER